Remarks

1. Summary of the Office Action

In the latest office action mailed February 20, 2009, the Examiner rejected claims 1, 4, 13, and 16 under 35 U.S.C. § 112 ¶ 2 as allegedly lacking antecedent basis, the Examiner rejected claims 1, 4, and 13 under 35 U.S.C. § 112 ¶ 2 as allegedly omitting essential elements, the Examiner maintained rejections of claims 1-6 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2003/0083041 (Kumar), and the Examiner maintained rejections of claims of claims 13-25 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,987,987 (Vacanti).

2. Status of the Claims

Pending are claims 1-6 and 13-25, of which claims 1, 4, 13, 16, and 20 are independent and the remainder are dependent.

3. Response to Rejections

a. Response to Antecedent Basis Rejections

As noted above, the Examiner rejected claims 1, 4, 13, and 16 on grounds of alleged lack of antecedent basis. A review of those claims shows, however, that the terms that the Examiner thought lacked antecedent basis in fact have proper antecedent basis. Therefore, the Examiner clearly erred in rejecting the claims on grounds of alleged lack of antecedent basis.

The Examiner asserted that claim 1 lacked antecedent basis for the line 6 recitation of "the web content" (which actually occurs in line 5, rather than line 6). Yet claim 1 introduces "web content" (without the word "the") in line 2, thus providing proper antecedent basis for the

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subsequent recitation of "the web content". Therefore, the antecedent basis rejection of claim 1 was improper.

The Examiner next asserted that claim 4 lacked antecedent basis for the line 3 recitation of "the web content". Yet claim 4 introduces "web content" (without the word "the") in line 1, thus providing proper antecedent basis for the subsequent recitation of "the web content". Therefore, the antecedent basis rejection of claim 4 was improper.

The Examiner next asserted that claim 13 lacked antecedent basis for the line 2 recitation of "the web content". Yet claim 13 introduces "web content" (without the word "the") in line 1, thus providing proper antecedent basis for the subsequent recitation of "the web content". Therefore, the antecedent basis rejection of claim 13 was improper.

And the Examiner next asserted that claim 16 lacked antecedent basis for the line 3 recitation of "the web content". Yet claim 16 introduces "web content" (without the word "the") in line 1, thus providing proper antecedent basis for the subsequent recitation of "the web content". Therefore, the antecedent basis rejection of claim 16 was improper.

b. Response to "Omitted Steps" Rejections

The Examiner rejected claims 1 and 4 on grounds that the claims recite "computing a size-based cost to access the web content" and "receiving user approval to pay the sized based cost" but do not recite "determining the size of the requested web content" and "advising the user of the size-based access cost." As a purported basis for this rejection, the Examiner cited M.P.E.P. § 2172.01 and asserted that the omitted steps were "essential" to the invention and therefore that the specification was non-enabling as not allowing for the invention to be implemented without those steps. Applicant submits that this rejection is clearly improper.

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The "determining" and "advising" steps are not "essential" steps, even though they are steps that can of course be carried out in an exemplary embodiment to implement the claimed invention.

The recited "computing a size-based cost to access the web content" is the pertinent step. As the specification teaches, that computing step can be implemented by determining the size of the web content and applying a cost to the determined size so as to compute a size-based cost. But merely because those are example enabling details for implementing the computing step does not mean that those enabling details are themselves essential steps to define the invention. Indeed, one faced with the language "computing a size-based cost to access the web content" in Applicant's claims would have little problem understanding what that step means. This is particularly so when the claim term is read in light of the specification, which makes clear by way of example what can be involved in implementing the computing step.

The requirement to claim "essential" matter in M.P.E.P. § 2172.01 clearly does not mean that an applicant needs to put all of the example enabling details into each claim. Rather, the claims serve to recite the invention, while the specification serves to provide those enabling details. By the same token, the mere disclosure in the specification of example implementation does not make that example implementation "essential" or mandatory to be claimed, particularly when what is in fact claimed is clear and understandable as is the case with claims 1 and 4.

M.P.E.P. § 2172.01 makes clear that matter is "essential" only if the specification describes that the matter is necessary to practice the invention. In the *In re Mayhew* case cited by M.P.E.P. § 2172.01, the court affirmed the rejection of a claim on grounds that the claim did not recite application of a cooling bath but the specification taught that the resulting product

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would be inferior if a cooling bath was not applied. There is no analogous situation here. Applicant's specification does not have any teaching that failure to determine a size of the content would somehow result in an inferior process. Furthermore, the *In re Mayhew* case additionally addressed another claim that recited specific aspects of the cooling process, and the court held that the claim did not need to recite those specific aspects but that it was sufficient that the claim recited the cooling process as a general matter. That is more like the present case, where there is no need for the claim to recite the "determining" function as an aspect of the recited "computing" function.

Moreover, although the Examiner cited to page 30, lines 15-21, of the specification as allegedly teaching that the "determining" function is essential to the invention, a review of that portion of the specification and the specification as a whole makes clear that the "determining" step is not essential but is rather merely an example implementation detail. In particular, the cited portion states:

> In accordance with the exemplary embodiment, the intermediation system will compute a cost to access given web content based at least in part on the size of the web content, such as the number of bits, bytes, characters or other units of data that make up the web content. For instance, the intermediation system could determine the size of the web content and then multiply the size by a charging rate, which could vary based on user, time/day, content provider or other factors.

Without question, that disclosure makes clear that determining the size of the content is merely an example implementation detail, which *can* be claimed but does not need to be claimed. In addition, the specification states at pages 8-9 that the disclosure of the specification is provided as an example only and that variations from the example disclosed are possible, including the possibility of omitting described features:

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> It should be understood, however, that this and other arrangements described herein are set forth for purposes of example only. As such, those skilled in the art will appreciate that other arrangements and other elements (e.g., machines, interfaces, functions, orders of functions, etc.) can be used instead, and some elements may be omitted altogether.

Largely the same is true for the "advising the user of the size-based cost" step that the Examiner alleged is "essential." But with respect to this step, it just so happens that claims 1 and 4 in fact do recite communicating with the client station to receive user approval. Thus, there is actually more to the recited claim features than merely "receiving user approval", as the claims literally recite engaging in interstitial communication with the client station for that purpose. The Examiner's assertion that the claims omit recitation of advising the user of the user of the size-based cost seems to disregard that the claims do recite such communicating with the client station to receive user approval. One faced with the claim would have no problem whatsoever understanding that the recited function can involve presenting the size-based cost so as to receive the user approval. Further, once again, it is clear from a reading of the specification that the disclosure of the specification is merely exemplary in terms of implementation details; the specification does not provide any teaching that an advising step is "essential," even though the specification clearly supports and enables the actually recited feature of engaging in interstitial communication with the client station to receive user approval to pay the size-based cost.

The Examiner additionally rejected claim 13 on largely the same basis, for omitting "detecting a hyperlink in web content being delivered to a client station" and "determining a size of the web content referenced by the hyperlink" when claim 13 recites "computing a size-based cost to access the web content." The points above apply here as well. Applicant's specification provides example implementation details for carrying out the actually recited claim features; yet

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that does not mean that the claim needs to recite those example details. Indeed, here again, the Examiner cited to a portion of the specification that states quite permissively what the intermediation system "could" do but provides no teaching that the features mentioned by the Examiner are somehow "essential" to the invention.

Ultimately, if the Examiner were correct about the missing features being "essential" and needing to be claimed, one could argue that Applicant's entire detailed description (all 30 or so pages) would need to be recited expressly in the claims, since the specification serves to provide example implementation details. Yet just as that result would be unnecessary, so to is it completely unnecessary to recite expressly the example implementation details noted by the Examiner.

Claims 1, 4, and 13 are clear and fully enabled by the specification. There are no "essential" missing features. Therefore, Applicant submits that the "omitted step" rejections should be withdrawn.

c. Response to Anticipation Rejections

The Examiner has repeated largely verbatim the anticipation rejections set forth in the previous office action. Applicant explained in the last response why those anticipation rejections were clearly improper, and Applicant maintains those points and respectfully requests the Examiner to review those points.

Further, the Examiner provided a "response to arguments" section that repeated much of what the Examiner stated in the "response to arguments" section of the last office action. Yet Applicant explained in the last response why the Examiner's "response to arguments" did not overcome the deficiency of the Examiner's rejections.

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In the latest "response to arguments" section, the Examiner did not seek to rebut what Applicant explained in the last response, particularly regarding the additional errors in the Examiner's "response to arguments".

For instance, the Examiner did not seek rebut the fact that Kumar is clearly directed to having the wireless device (i.e., the client) estimate the cost of a desired session *before the wireless device sends a request for the content, i.e., before the wireless device actually initiates the session*, and the fact that it would be impossible in that scenario for the cost to be computed *during* transmission of the web request from the client to the content server, since the web request has not yet been transmitted at the time the cost is computed by the client. Kumar thus fails to teach ***computing* a size-based cost *during transmission of the web request within the communication path from a client station to a content server, between the client station and the content server***.

The Examiner asserted that "computing a size-based cost to access the web content" without "determining the size of the requested web content" is at best merely an estimate of the cost. But putting aside the fact that claim 1 does not preclude determining the size of requested web content, and thus without acquiescing in the Examiner's assertion, the Examiner's point does not justify the anticipation rejection. Even if the claim did recite "estimating" a size-based cost rather than "computing" a size-based cost, the fact remains that the claim recites the computing function occurring during transmission of the web request within the communication path from the client station to the content server, between the client station and the content server, and so Kumar's mere disclosure of the client station computing or estimating a cost cannot possibly amount to the claim feature.

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The Examiner additionally noted that the claim 1 feature of "after receiving the user approval, sending the request along to the content server" means the device sends a request for the content before the device actually initiates the session. Yet putting aside the merits of this assertion (which Applicant does not address or concede), the point does not relate to the actual deficiency of Kumar, which is at a minimum that Kumar fails to teach the claim feature of ***computing* a size-based cost *during transmission of the web request within the communication path from a client station to a content server, between the client station and the content server***.

Because Kumar fails to teach the invention recited by any of claims 1-6, Kumar does not anticipate the claims. Consequently, the rejection of the claims as being allegedly anticipated by Kumar is clearly improper and should be withdrawn.

The Examiner also erred in maintaining the rejections of claims 13-25 as being allegedly anticipated by Vacanti. In the last response, Applicant explained in detail why the Examiner was wrong, at a minimum because Vacanti does not teach ***computing a size-based cost to access the web content and adding an indication of the size-based cost into the web content in conjunction with the hyperlink, such that the indication of the size-based cost will be presented to a user when the web content is presented to the user.***

As noted by the Examiner, Vacanti teaches embellishing a hyperlink with an indication of cost to access the referenced web content. However, Vacanti does not teach embellishing the hyperlink with a *size-based cost* to access the referenced web content. Therefore, Vacanti does not anticipate claims 13, 16, and 20.

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As Applicant noted in the last response, Vacanti's disclosure at column 20, lines 51-55, of users paying in advance for a quantity of access (as cited by the Examiner) has nothing to do with determining a size-based cost of given content. At best, that teaching in Vacanti may relate to a limitation on the quantity of data being communicated. It does not teach anything about determining a cost based on a given quantity of data (if that is what the Examiner meant), and more specifically it does not disclose the claim function of computing a size-based cost to access the web content. Applicant's claims recite that function; the Vacanti reference does not teach that function.

In the latest "response to argument" section, the Examiner once again asserted that Vacanti's disclosure of a user paying in advance for "quantity of access", as well as Vacanti's disclosure of adding cost into web content being delivered to a user, amounts to Applicant's "computing a size-based cost to access the web content" function. However, that conclusion is incorrect. The cited Vacanti disclosure does not expressly teach computing a size-based cost to access the web content, and such a teaching does not follow necessarily from Vacanti's teachings and is therefore not inherent in Vacanti. It is entirely plausible within the teachings of Vacanti that content cost can be computed on a basis that has nothing to do with the size of the content requested. For instance, content cost can theoretically be computed based on a predefined cost associated with the content file (e.g., based on the usefulness of the content file), such as by reference to a lookup table that lists costs and URLs, as in Vacanti at Figure 13.

Furthermore, here too the Examiner asserted that "computing a size-based cost to access the web content" without "determining the size of the requested web content" is at best merely an estimate of the cost. But putting aside the fact that claim 13 does not preclude determining the

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size of requested web content, and without acquiescing in the Examiner's assertion, the Examiner's point does not justify the anticipation rejection. Even if the claim did recite "estimating" a size-based cost rather than "computing" a size-based cost, the fact remains that the claim recites ***computing a size-based cost to access the web content and adding an indication of the size-based cost into the web content in conjunction with the hyperlink, such that the indication of the size-based cost will be presented to a user when the web content is presented to the user***, and Vacanti simply does not disclose that feature.

Because Vacanti fails to teach the invention recited by any of claims 13-25, Vacanti does not anticipate the claims. Consequently, the rejection of the claims as being allegedly anticipated by Vacanti is clearly improper and should be withdrawn.

4. Conclusion

For the foregoing reasons, Applicant submits that all of the pending claims are in condition for allowance, and Applicant thus respectfully requests favorable reconsideration.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is welcome to call the undersigned at (312) 913-2141.

Respectfully submitted,

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